

REMARKS

Claims 1-70 are pending in the subject application. In the present Office Action, claims 1-10, 13, 15-19, 22-29, 34-36 and 40-42 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Wende et al., *Journal of the American Chemical Society*, (2001) 123, 11490-11491 ("the JACS Article"). Claims 45-70 are allowed. Claims 11, 12, 14, 20, 21, 30-33, 37-39, 43, and 44 are held allowable but are objected to as being dependent upon a rejected base claim. Applicants acknowledge, with appreciation, the Examiner's finding of allowable subject matter in claims 11, 12, 14, 20, 21, 30-33, 37-39, 43-70 and respectfully traverse the rejection of claims 1-10, 13, 15-19, 22-29, 34-36 and 40-42 as set forth herein.

Rejection under 35 U.S.C. § 102(a)

Claims 1-10, 13, 15-19, 22-29, 34-36 and 40-42 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the JACS Article. 35 U.S.C. § 102(a) states:

"A person shall be entitled to a patent unless-
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent." (35 U.S.C. § 102(a)).

In interpreting § 102(a), the MPEP states: "Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. § 102(a)." (MPEP § 2133, citing *In re Katz*. 687 F.2d 450, 215 USPQ 14 (CCPA 1982)). A rejection under 35 U.S.C. 102(a) can "be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work." (MPEP § 2133, citing *In re Katz*. 687 F.2d 450, 215 USPQ 14 (CCPA 1982)). Applicants respectfully assert that the JACS Article is a disclosure of the Applicants' own work within the year before the application priority date and submit herewith a Declaration under 37 C.F.R. 1.132 by co-inventor John A. Gladysz to establish the same. Therefore, the JACS Article cannot be used as prior art against Applicants under 35 U.S.C. § 102(a).

The JACS Article was authored by co-inventors Gladysz and Wende as well as a third co-author, Ralf Meier. As established in the Declaration of Professor John A. Gladysz (attached hereto), Dr. Ralf Meier was a post-doctoral fellow working under the direction and supervision of co-inventor Gladysz in Professor Gladysz's research group at the University of Utah and the Universität of Erlangen-Nürnberg in Germany. The JACS Article was a scientific research paper in which co-workers involved with assays and testing are normally listed as co-authors. The JACS Article describes two areas of research involving fluororous catalyst recovery in the Gladysz research group: a) liquid-liquid biphasic conditions (not claimed in the subject application) and b) liquid-solid conditions (described in the claims of the subject application). As shown in the Gladysz Declaration, while working under Professor Gladysz's direction and supervision, Dr. Meier developed some of the chemistry described in the JACS Article involving catalysis and catalyst recovery under the liquid-liquid biphasic conditions, including the making the starting materials, preparing authentic samples of the products, and developing conditions for chromatographic and NMR analyses. However, Dr. Meier was not involved in any experimentation or research involving catalysis or catalyst recovery under liquid-solid conditions, which is the subject matter of claims 1-10, 13, 15-19, 22-29, 34-36 and 40-42 of the subject application. Therefore, while Dr. Meier was listed as a co-author on the JACS Article in recognition of his preliminary contributions to the studies on liquid-liquid biphasic conditions, he is not a co-inventor of claims 1-10, 13, 15-19, 22-29, 34-36 and 40-42 in the subject application.

In view of the Gladysz Declaration and the precedent established by the Courts in *In re Katz*, Applicants respectfully submit that the JACS Article is a disclosure of Applicants' own work within the year before the application priority date and that the JACS Article cannot be used as a prior art reference under 35 U.S.C. § 102(a). Further, since the JACS Article disclosure date was less than one year prior to the application priority date, it cannot serve as a prior art reference under 35 U.S.C. § 102(b). Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-10, 13, 15-19, 22-29, 34-36 and 40-42 under 35 U.S.C. § 102(a) in view of the JACS Article.

CONCLUSION

Applicants submit that claims 1-70 of the subject application recite novel and non-obvious methods of conducting a chemical reaction in a non-fluorous medium using a using a fluorous compound in the presence of a solid adsorbant containing a fluorous domain. In view of the Declaration under 37 C.F.R. 1.132 and remarks presented herein, Applicants respectfully submit that all claims in the subject application are in condition for allowance. Accordingly, reconsideration of the rejection and allowance of all pending claims is earnestly solicited.

If the undersigned can be of assistance to the Examiner in addressing issues to advance the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted,



Joseph L. Kent
Registration No. 54,216

KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, PA 15222-2312
Telephone: (412) 355-8315
Facsimile: (412) 355-6501

Customer No. 26,285